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10/536,499

10/28/2005

Richard David Saunders

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EXAMINER

MAI, THIEN T

ART UNIT

PAPER NUMBER

2887

NOTIFICATION DATE

DELIVERY MODE

03/31/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

|                              |                                      |                                                |  |
|------------------------------|--------------------------------------|------------------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/536,499 | <b>Applicant(s)</b><br>SAUNDERS, RICHARD DAVID |  |
|                              | <b>Examiner</b><br>Thien T. Mai      | <b>Art Unit</b><br>2887                        |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                        |                                                                   |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/25/05, 10/28/05</u> .                                       | 6) <input type="checkbox"/> Other: _____                          |

### ***Acknowledgement***

1. Acknowledgement is hereby made of preliminary Amendment filed 5/25/2005.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Specification***

3. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

#### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

### ***Claim Objections***

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4. Claim 9, directed to a different method of storing magnetic data, is an improper dependent claim. Claim 9 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in proper independent form. Claim 9 depends on claim 1 but at the same time appears to be in independent form claiming a different method.

5. Claims 10-11, directed to a document or other sheet products, are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in proper independent form. Claim 10-11 depends on claim 1 but at the same time appears to be in independent form.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 4 line 4 on page 5: it is unclear as to whether the outer sheet is referring to a single outer sheet or the pair of outer sheets. For examination purposes, it is broadly interpreted as a single outer sheet.

8. Regarding claim 6, the phrase "similar equipment" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by

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"similar equipment"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

9. Regarding claim 10-11, the phrase "other sheet product" renders the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "other sheet product"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claim(s) 1-11 is/are rejected under 35 U.S.C. 102(e) as being anticipated by *Nakano* (US 6391439 B2)

*Nakano* discloses:

1. A method of verifying the accuracy or authenticity of alphanumeric magnetic data on a document, wherein:

(a) the configuration of a pictorial or graphic magnetic reference image in the document is made visible (col. 1 lines 5-12) by bringing movable particulate magnetic material into proximity therewith such that the particulate magnetic material takes up a distribution corresponding to the magnetic field of the reference image; and (b) the

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magnetic image configuration thus revealed is compared with the reference image to identify any significant disconformity suggesting past exposure of the document to a magnetic field capable of altering said magnetic data or images (col. 1 lines 25-29, col. 29, col. 5 line 62-col. 6 line 5: label document A is used to reversibly write images including music pieces thereon so at least a music recording different from a last one would visibly indicate substantial disconformity; col. 1 lines 45-64, col. 2 lines 30-67, col. 3 lines 1-27, col. 4 lines 6-62: rewritable document A comprises magnetic recording layer 2 and microcapsules 11 that are reversibly programmed to yield an opaque or transparent state)

2. A method as claimed in claim 1, in which the document also carries visible information (col. 1 lines 45-64, col. 2 lines 30-67)

3. A method as claimed in claim 1, in which the document carries a layer of magnetic material which has a coercivity which is substantially uniform across its area (col. 4 lines 4-5).

4. A method as claimed in claim 1, in which the document comprises a pair of laminated outer sheets between which is a magnetic layer comprising magnetically-activatable particles 11 (Fig. 2-3) in a binder matrix 13, the outer sheet having sufficient opacity to mask the appearance of the magnetic layer (col. 4 lines 36-62: outer base layer 1 is black and is made of synthetic paper)

5. A method as claimed in claim 4, wherein said outer sheets are of natural or synthetic paper (col. 4 lines 36-62: outer base layer 1 is black and is made of synthetic paper).

6. A method as claimed in claim 4, wherein the magnetic layer is formed by a coating on the inwardly facing surface of one or both of the outer sheets, or by a laminating adhesive which is applied as or just before the two outer sheets are brought together in a laminating press or similar equipment (col. 5 lines 30-67, Fig. 1).

7. A method as claimed in claim 4, in which at least one outer sheet carries a pigment/binder coat on its inward facing surface (Fig. 1 shows outer sheet 1 is next to a primer layer 6).

8. A method as claimed in any one of claims claim 4, at least one of the outer sheets being provided on its outward facing surface with a coating which comprises either microcapsules containing a solution of at least one chromogenic material, or dispersed droplets containing at least one chromogenic material in a pressure-rupturable matrix, or a colour developer composition, or both microcapsules containing at least one chromogenic material and also a colour developer (col. 4 line 6-40+: layer 2 and microcapsules comprise color developer composition).

9. A method of storing alphanumeric magnetic data on a document and subsequently confirming its authenticity, which comprises storing a pictorial or graphic magnetic reference image on the document; writing said alphanumeric magnetic data to the document; and subsequently verifying the accuracy of said alphanumeric magnetic data by a method as claimed in claim 1 (col. 1 lines 25-29, col. 29, col. 5 line 62-col. 6 line 5: label document A is used to reversibly write image data including music pieces thereon so at least a music recording different from a previous one would visibly indicate substantial disconformity).

10. A document or other sheet product suitable for verification by a method as claimed in claim 1 which comprises magnetic material which has a coercivity which is substantially uniform across its area, and which carries a pictorial or graphic magnetic reference image in addition to alphanumeric magnetic data (col. 4 lines 4-5).

11. A document or other sheet product suitable for verification by a method as claimed in claim 1 which comprises a pair of laminated outer sheets between which is a magnetic layer comprising magnetically-activatable particles in a binder matrix, the outer sheet having sufficient opacity to mask the appearance of the magnetic layer, and which carries a pictorial or graphic magnetic reference image in addition to alphanumeric magnetic data (col. 1 lines 25-29, col. 29, col. 5 line 62-col. 6 line 5: label document A is used to reversibly write images including music pieces thereon so at least a music recording different from a last one would visibly indicate substantial disconformity; col. 1 lines 45-64, col. 2 lines 30-67, col. 3 lines 1-27, col. 4 lines 6-62: rewritable document A comprises magnetic recording layer 2 and microcapsules 11 that are reversibly programmed to yield an opaque or transparent state).

### ***Remarks***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: see form PTO-892 for methods disclosed in other prior art for measuring and verifying authentication magnetic data.

### ***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve S. Paik can be reached on 571-272-2404. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thien T Mai/  
Examiner, Art Unit 2887

/DANIEL WALSH/  
Primary Examiner, Art Unit 2887